

### **REMARKS**

Claims 14-21 are pending and stand rejected. Claims 1-13, 22, and 23, drawn to non-elected inventions, are canceled without prejudice or disclaimer. Claims 14-16 have been amended. Support for these amendments can be found, for example, in paragraphs [0019] and [0020] of the Specification as well as in FIGS. 1-3. No new matter is added herein.

Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references.

#### **Election/Restrictions**

Claims 1-13 and 22-23 have been canceled as drawn to non-elected inventions. Applicants note that, since the present Office Action is a non-final action, the Examiner has utilized the incorrect form paragraph. Rather than form paragraph 8.24, the Examiner should have used form paragraph 8.05. MPEP § 821.01. Applicants therefore respectfully request that the Examiner indicate that the restriction requirement was timely traversed on September 29, 2005 in any subsequent actions.

#### **Rejection Under 35 U.S.C. § 112**

The Examiner rejects claims 14-15 under 35 U.S.C. § 112 ¶ 2 as indefinite for failing to particularly point and distinctly claim the subject matter of the invention. In particular, the Examiner objects to the recitations "said first layer" in claim 14 and "said first forming" in claim 15. Applicants respectfully submit that these rejections are overcome in light of the foregoing amendments.

#### **Rejection Under 35 U.S.C. § 102(e)**

The Examiner rejects claims 14-15, 17, and 19-20 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,016,848 to Egres, Jr. ("Egres"). To anticipate a claim, a single prior art reference must expressly or inherently disclose each and every element of the claimed

invention. MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987)). Applicants respectfully submit that Egres fails to meet this standard.

Claim 14 recites “*extruding* a smooth inner fluoropolymer layer; [and] forming a *substantially continuous* jacket over the inner fluoropolymer layer...” (emphasis added). That is, first layer 12 is extruded, Specification, paragraph [0021], and jacket 14 is disposed about substantially all of first layer 12, Specification, paragraph [0023]; see also FIGS. 1-3.

Egres, by contrast, does not teach “extruding a smooth inner fluoropolymer layer[.]” Rather, Egres teaches forming the inner layer by wrapping a bi-axially expanded PTFE membrane about a mandrel. Egres, Col. 6, Lines 37-43. Nor does Egres teach “a substantially continuous jacket over the inner fluoropolymer layer[.]” Rather, as clearly illustrated in FIG. 11, Egres teaches discontinuous reinforcing ribs or rings 55. See also Egres, Col. 9, Lines 51-54.

Egres therefore fails to disclose each and every element of, and thus cannot anticipate, claim 14. Claims 15, 17, 19, and 20, which depend from claim 14, are allowable for at least the same reasons. Applicants accordingly respectfully request withdrawal of the rejection under 35 U.S.C. § 102(e).

### **Rejection Under 35 U.S.C. § 103**

#### *Claim 16*

The Examiner rejects claim 16 under 35 U.S.C. § 103 as obvious over Egres in view of U.S. Patent No. 3,976,414 to Hegler et al. (“Hegler”). To establish a *prima facie* case of obviousness, the Examiner must demonstrate some suggestion or motivation to combine one or more references, with a reasonable expectation of success, to teach each and every claimed limitation. MPEP § 2142. Applicants submit that the Examiner has failed to meet this burden.

As described above, Egres fails to teach “a substantially continuous jacket over the inner fluoropolymer layer[.]” Hegler does not cure this deficiency. Rather, Hegler teaches that the outer tube abuts the inner tube only at the nadir of the corrugations of the outer tube. Hegler, Col. 1, Lines 9-13; see also FIGS. 1-3 (illustrating discontinuities between first and second streams of plastic 3, 7 formed by train of molds 4). Thus, Applicants contend that the asserted combination fails to teach each and every element of the present invention.

Further, Applicants submit that the asserted prior art teaches away from the claimed invention. As described above Egres teaches that the inner layer is formed by wrapping a PTFE membrane about a mandrel. Far from suggesting the desirability of the claimed extrusion step, invention, Egres expressly disfavors the use of an extruded inner layer. Egres, Col. 1, Lines 47-50. Consequently, one of ordinary skill in the art would clearly not consider modifying Egres by extruding the inner layer, for example by combining Egres with Hegler, which teaches concurrent extrusion of *both* the inner layer *and* the outer layer, lest the advantages of the Egres membrane-wrapped construction become lost in the resultant combination.

Since the asserted references teach away from the claimed invention, the combination improper, and cannot be used to sustain a *prima facie* case of obviousness. Further, even if the combination were proper, it would fail to teach each and every element of claim 16. Applicants therefore earnestly solicit withdrawal of the rejection of claim 16 under section 103.

#### *Claim 18*

The Examiner rejects claim 18 under 35 U.S.C. § 103 as obvious over Egres in view of U.S. Patent No. 5,653,266 to Reynolds et al. (“Reynolds”). Applicants respectfully disagree.

As described above, Egres teaches away from the claimed invention insofar as it clearly disfavors the use of extrusion. Like Hegler, Reynolds teaches extrusion. Reynolds, Col. 3, Lines 36-40. Since the asserted prior art teaches away from the claimed invention, the rejection is improper and should be withdrawn.

#### *Claim 21*

The Examiner rejects claim 21 under 35 U.S.C. § 103 as obvious over Egres in view of U.S. Patent No. 5,324,557 to Lupke (“Lupke”). Applicants respectfully disagree.

As described above, Egres teaches away from the claimed invention insofar as it clearly disfavors the use of extrusion. Like Hegler and Reynolds, Lupke teaches extrusion. Lupke, Col. 3, Lines 62-68. The Examiner has therefore failed to establish that claim 21 is *prima facie* obvious, and Applicants respectfully request withdrawal of the rejection of claim 21 under 35 U.S.C. § 103.

**Double Patenting Rejection**

The Examiner rejects claims 14-21 on the ground of non-statutory obviousness-type double patenting over U.S. Patent No. 6,641,884 to Martucci et al. ("Martucci '884") in view of Egres (claims 14-15, 17, and 19-20), Egres and Hegler (claim 16), Egres and Reynolds (claim 18), and Egres and Lupke (claim 21).

The Examiner rejects claims 14-21 on the ground of non-statutory obviousness type double patenting over U.S. Patent No. 6,948,528 to Martucci et al. ("Martucci '528") in view of Egres (claims 14-15, 17, and 19-20), Egres and Hegler (claim 16), Egres and Reynolds (claim 18), and Egres and Lupke (claim 21).

As an initial matter, Applicants reiterate that Egres disfavors extrusion. Both Martucci '884 and Martucci '528 teach that inner layer 12 is extruded. Martucci '884, Col. 4, Lines 8-21; Martucci '528, Col. 4, Lines 13-26. Thus, as noted above, the prior art teaches away from the claimed invention. Applicants accordingly respectfully submit that the rejection is improper and should be withdrawn.

In the alternative, Applicants respectfully request withdrawal of the double patenting rejections in light of the enclosed Terminal Disclaimer under 37 C.F.R. § 1.321.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance, and request that all rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

Applicants believe that a two month extension of time is necessary for this paper to be considered timely filed, and hereby petition for such extension under 37 C.F.R. § 1.136. A check in the amount of \$450 is enclosed. In the event further extensions of time are required for this paper to be considered timely, Applicants hereby make a conditional petition therefor. Please

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charge any deficiencies in fees and credit any overpayments to Deposit Account No. 50-2036  
with reference to Attorney Docket No. 79287.21501.

Respectfully submitted,

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